

II. REMARKS

A. Introduction

In this Office Action claims 1-14 are noted as pending and rejected based on prior art, and claims 4, 5 and 14 are objected to.

In summary of this Response, claims 2, 4, 6, 9, 11 and 13 are canceled, claims 1, 3, 5, 7, 8, 10, 12 and 14 are amended, and remarks are provided.

B. Double Patenting Rejection

Claims 1-14 of the present application are provisionally rejected for obviousness-type double patenting over claims 1-10 of co-pending application serial number 10/863,875, U.S. Published Patent Application No. 2004-0224119.

As application serial no. 10/863,875 has not yet issued as a patent, and since the respective applications may be amended through prosecution to render such a rejection moot, it is not believed that any comments are necessary at this time related to this provisional rejection.

C. Claim Objection

Claims 4, 5 and 14 are objected to for failing to further limit the claims from which they depend.

Claim 4 is cancelled herein so no further comments regarding this claim are necessary.

Claim 5 recites the first magnetic soft layer is metallic foil coated directly on the substrate, which is different from independent claim 1, from which it ultimately depends, which recites that the first soft magnetic layer is simply "formed on" the substrate. Claim 14 indicates that the first soft magnetic layer of claim 1 is coated directly on the substrate. It is believed that the terms "formed on" and "coated" can have different meanings such that the former does not necessarily mean "directly in contact with". See, for example, AFG Industries, Inc. v. Cardinal IG Company, 57 USPQ2d 1776, 1786 (Fed.Cir. 2001), copy attached as Exhibit A. In the present case, claims 5 and 14 recite "directly", and thus further define the invention of claim 1.

D. Rejection of Claims 1-14 Under 35 U.S.C. § 102(e)(2) Based on the Above Noted Published Application

It is believed that for a reference to be applicable as prior art under § 102(e)(2), the International Application upon which it is based (i.e., it appears that the published application is a section 111a Continuation of an International Application), must have designated the United

States and was published under Article 21(2) of such treaty in the English language." 35 U.S.C. § 102(e)(2). In the present instance, it appears that the PCT Application was published as Publication No. WO 03/056555 in Japanese. See the attached cover sheet for the publication, Exhibit B), and the copy of the flow chart from MPEP § 706.02 (f)(1), attached as Exhibit C.

Therefore, it is not believed the reference qualifies as prior art under this section for the December 25, 2001 filing date upon which the Examiner relies. Instead, the applicable reference date would appear to be June 8, 2004, the U.S. filing date, which post-dates even the U.S. filing date of the present application.

E. Rejection of Claims 1-11 and 14 Under 35 U.S.C. § 102(b)

These claims are rejected as being anticipated by Iwabuchi et al. (U.S. Patent No. 5,287,334).

As noted above, claims 2, 4, 6, 9 and 11 are cancelled herein. Nevertheless, it is respectfully submitted that the present invention, as recited by claims 1, 3, 5, 7-8, 10 and 14, was neither anticipated nor rendered obvious by this reference.

The present invention is recited in independent claim 1 as a device including both the medium and the head, wherein the flux density and thickness of the respective soft magnetic layers thereof have a specific ratio relationship. Iwabuchi et al. fails to teach or suggest the recited structure of the head or the ratio relationship, regardless of its medium's structure.

F. Rejection of Claims 1-11 and 14 Under 35 U.S.C. § 102(b)

These claims are rejected as being anticipated by Nakajima (U.S. Patent No. 6,212,137).

Again, it is respectfully submitted that the present invention, as recited by claims 1, 3, 5, 7-8, 10 and 14, was neither anticipated nor rendered obvious by this reference.

As noted above, claim 1 recites a device including both the medium and the head, wherein the flux density and thickness of the respective soft magnetic layers exhibit a specific ratio. Nakajima, like Iwabuchi et al., fails to teach or suggest the head or the ratio relationship, regardless of its medium's structure.

G. Rejection of Claims 12 and 13 Under 35 U.S.C. § 103

These claims are rejected as being made obvious by a combination of Nakajima and Shimizu et al. (U.S. Patent Publication No. 2002/0012816).

As, claim 13 is cancelled, it is respectfully submitted that claim 12 was not rendered obvious by this combination.

Regardless of the teaching of this secondary reference, same lacks disclosure to compensate for the incomplete teaching of the primary Nakajima reference discussed above in regard to the head structure and the ratio.

H. Rejection of Claims 12 and 13 Under 35 U.S.C. § 103(a)

These claims are rejected as being rendered obvious by Iwabuchi et al., and further in view of Shimizu et al.

Regardless of the teaching of this secondary reference as it relates to claim 12, this reference lacks sufficient disclosure to compensate for the incomplete teaching of Iwabuchi et al. in regard to the head structure and the ratio.

III. CONCLUSION

In light of the above amendments and remarks, it is respectfully submitted that claims 1, 3, 5, 7, 8, 10, 12 and 14 are now in condition for allowance.

If there are any additional fees associated with this Response, please charge same to our Deposit Account No. 19-3935.

Finally, if there are any formal matters remaining after this Response, the undersigned would appreciate a telephone conference with the Examiner to attend to these matters.

Respectfully submitted,

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